

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1, 4-10, 13-14, 17-23, 26-28, 30-45 are pending, claims 1, 4-10, 13-14, 17-23, 28, 30, and 32 have been amended, claims 2, 3, 11, 12, 15, 16, 24, 25, and 29 have been cancelled. Claims 38-45 have been added, and claims 34-37 have been indicated as withdrawn by an oral election in response to the restriction.

Prior Art Rejections

1. Rejection under 35 U.S.C. § 102 (b) based on Chenausky

Claims 1-5, 8, 13, 15-17, 21, 28, 32, and 33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Chenausky et al. (U.S. Patent No. 4,438,514). This rejection is respectfully traversed.

Applicant directs the Examiner's attention to amended claims 1 and 13.

Amended Independent claims 1 and 13 state: "where the at least two sidewalls are sectional sidewalls..."

Chenausky is directed to a waveguide laser having two waveguides 132 and 134 (Chenausky, Figures 1-4; col. 1, ll. 43-47). As shown the waveguides are channels (Chenausky, col. 2, line 4), in a ceramic block 122 (Chenausky, col. 1, 60). The ceramic block 122 separates two electrodes 110, and 112 (Chenausky, Figure 1; col. 1, line 46). The ceramic block 122 in Chenausky completely covers the surface of at least one electrode, and thus any sidewall in Chenausky is non-sectional.

For anticipation under 35 U.S.C. § 102 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)(M.P.E.P. 2131). For reasons stated above Applicant asserts that all of the elements of claims 1 and 13 fail to be set forth in Chenausky

and, thus, Chenausky fails to anticipate claims 1 and 13. Likewise, Chenausky fails to anticipate dependent claims 2-5, 8, 15-17, 21, 32, and 33, which depend on either claim 1 or 13, and fail to be anticipated for at least the reasons set forth above.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-5, 8, 13, 15-17, 21, 28, 32, and 33 under 35 U.S.C. § 102(b) based on Chenausky.

2. Rejection under 35 U.S.C. § 102 (b) based on Yarborough

Claims 1-5, 8, 13, 15-17, 21, 26-28, 32 and 33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Yarborough et al. (U.S. Patent No. 5,140,606). This rejection is respectfully traversed.

Amended Independent claims 1 and 13 contain at least two sectional sidewalls.

Yarborough et al. illustrates a dielectric bracket 60 configured so that only three narrow brackets (60) on each side of the electrodes are used, thereby the discharge region is substantially unblocked (Yarborough, col. 7, ll. 27-31). Yarborough fails to show, suggest, or teach sectional sidewalls as disclosed in the present application's disclosure.

Thus, Applicant asserts that all of the elements of claims 1 and 13 fail to be set forth in the embodiment shown in Yarborough and, thus, Yarborough fails to anticipate claims 1 and 13. Likewise, Yarborough fails to anticipate dependent claims 2-5, 8, 15-17, 21, 26-27, 32 and 33, which depend on either claim 1 or 13, and fail to be anticipated for the same reasons Yarborough fails to anticipate claims 1 and 13.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-5, 8, 13, 15-17, 21, 26-28, 32 and 33 under 35 U.S.C. § 102(b) based on Yarborough.

3. Rejection under 35 U.S.C. § 102 (b) based on Vitruk

Claims 1-5, 8, 10-13, 15-18, 21, and 23-25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Vitruk et al. (U.S. Patent No. 5,953,360). This rejection is respectfully traversed.

As discussed above Amended Independent claims 1 and 13 contain at least two sectional sidewalls.

Vitruk et al. shows a ceramic spacer 276 (Vitruk, Figure 8; col. 6, line 26) or additional electrodes 74 and 78 (Vitruk, Figure 2; col. 2, ll. 45-47). Vitruk fails to show, suggest, or teach sectional sidewalls as disclosed in the present application's disclosure.

Thus, Applicant asserts that all of the elements of claims 1 and 13 are not disclosed or suggested in Vitruk and, thus, Vitruk fails to anticipate claims 1 and 13. Likewise, Vitruk fails to anticipate dependent claims 2-5, 8, 10-12, 15-18, 21, and 23-25, which depend on either claim 1 or 13, and therefore are allowable for similar reasons as those discussed above.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-5, 8, 10-13, 15-18, 21, and 23-25 under 35 U.S.C. § 102(b) based on Vitruk.

4. Rejection under 35 U.S.C. § 102 (b) based on Shackleton et al.

Claims 1-5, 8, 9, 13, 15-17, 21, 22, 26-28, 32 and 33 stand rejected under 35 U.S.C. §102(e) as being anticipated by Shackleton et al. (U.S. Publication No. US 2003/00588913 A1). This rejection is respectfully traversed.

As discussed above Amended Independent claims 1 and 13 contain at least two sectional sidewalls.

Shackleton et al. shows the use of insulating (e.g. 60 and 70) spacers (Shackleton, Figures 2-7; pg. 2, para 26; pg. 3, para 30). Shackleton states: "The present invention is

based on an assumption that although a substantial portion (about 78%) of the edge of gap 28 is not covered by insulators 60..." (Shackleton, pg. 3, para 28). Thus, Shackleton illustrates the use of spacers not side walls.

Thus, Applicant asserts that all of the elements of claims 1 and 13 fail to be set forth in the embodiment(s) shown in Shackleton and, thus, Shackleton fails to anticipate claims 1 and 13. Likewise, Shackleton fails to anticipate dependent claims 2-5, 8, 9, 15-17, 21, 22, 26-28, 32 and 33, which depend on either claim 1 or 13, and fail to be anticipated for the same reasons Shackleton fails to anticipate claims 1 and 13.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 11-5, 8, 9, 13, 15-17, 21, 22, 26-28, 32 and 33 under 35 U.S.C. § 102(e) based on Shackleton.

5. Rejections under 35 U.S.C. § 103 (b).

Claims 6, 7, 19, and 20 have been rejected as under 35 U.S.C. § 103(a) as being unpatentable over Yarborough.

Claims 14 and 29 have been rejected as under 35 U.S.C. § 103(a) as being unpatentable over Yarborough in view of Mixon et al. (U.S. Patent No. 5,764,505).

Claims 30 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yarborough. The Examiner alleges that it would have been obvious to one of ordinary skill to use "any element that surrounds the waveguide as housing."

As indicated above Yarborough fails to show, suggest, or teach sectional sidewalls as recited in Applicant's claimed combinations. Likewise, Mixon fails to show, suggest, or teach sectional sidewalls as disclosed in the present application's disclosure. Thus Yarborough and Mixon are both missing elements of independent claims 1 and 13.

To establish a *prima facie* case obviousness under 35 U.S.C. § 103, the Examiner has the burden of meeting the following three basic criteria: (1) the prior art must teach or

suggest all of the claim limitations; (2) there must be a reasonable expectation of success; and (3) there must be some suggestion or motivation, either in the art or knowledge generally available to one of ordinary skill in the art to modify the reference or to combine teachings (M.P.E.P. § 2143)(emphasis added). Thus, Yarborough, or Yarborough in view of Mixon (assuming the references are combinable, which Applicant fails to admit), fails to show, suggest, or teach all of the elements of independent claims 1 and 13. Likewise, Yarborough, or Yarborough in view of Mixon (assuming the references are combinable, which Applicants fails to admit) fails to teach, show, or suggest all the features of dependent claims 6, 7, 14, 19, 20, and 29-31, which depend on either claim 1 or 13, since the references fail to show, suggest, or teach all of the features of claims 1 and 13.

Accordingly Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims since claims 6, 7, 14, 19, 20, and 29-31 under 35 U.S.C. § 103(a).

New Claims

New claims 38-45 are added to this application and further define the inventive features supported by the present application. Claims 38, 44-45 are patentable over the references cited for the same reasons cited above as to why claims 1 and 13 are patentable over the references. Claim 39-43 are definable over the references since the references fail to show protrusions that aid in discharge in the discharge region.

Interview Request

If the response herein fails to place the application in condition for allowance, Applicant requests an interview at the convenience of the Examiner, to discuss any outstanding issues.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the formal objections and rejections to the claims, and the rejections based on prior art. Because all claims are believed to define over prior art of record, Applicant respectfully requests an early indication of allowability.

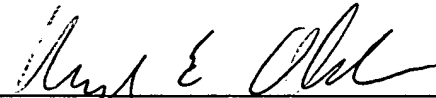
If the Examiner has any questions concerning this application, the Examiner is requested to contact the undersigned at (703) 740-8322 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayments to Deposit Account No. 50-3136 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

KEADY, OLDS & MAIER PLLC

By



Mark E. Olds
Reg. No. 46,507

JPK/MEO

P.O. Box 1817
Alexandria, VA 22313
(703)740-8322